

REMARKS

The Examiner is thanked for the performance of a thorough search. By this response, Claims 1–4, 6, 8–9, 11, 15–16, 25, 29–32, 36–39, 41, 43–44, 46, 50–51, 60, 64–67, 71, 72, 77, 88, 96, 98, 99, and 101 have been amended. Claims 12, 47, 78, 81–83, 90, 93–95, 97, 100, and 102–115 have been canceled. Claims 116–123 have been added. Hence, Claims 1–4, 6–9, 11, 12, 15, 16, 18, 25, 29–33, 36–39, 41–44, 46, 47, 50, 51, 53, 60, 64–68, 71–77, 84–89, 96–101, and 116–123 are pending in this application.

All issues raised in the final Office Action mailed September 1, 2009 are addressed hereinafter.

I. INTERVIEW SUMMARY

Applicants thank the Examiner for the telephone interview conducted on November 5, 2009 (hereinafter “Interview”). Examiner Loftus represented the USPTO. Applicants were represented by Karl T. Rees and Brian Hickman. The parties discussed Claim 96, as well as proposed amendments to Claim 1 in view of the cited references. In particular, Applicants pointed out that Claim 1, as presently amended, requires that a third party determine what content is being requested by or provided from a provider based on information in an intercepted message other than the provider’s Internet Protocol (“IP”) address (e.g. a GET request in the payload of the IP packet). By contrast, a toll switch, as described in *Kawecki*, would be incapable of determining what content was being requested in a message based on information other than the number to which a phone call was addressed. Applicants further pointed out that it would be impossible for *Kawecki* to bill on the basis of messages intercepted in route from the provider to the requestor, as recited in Claim 96. In response, Examiner suggested that Applicants submit their arguments and amendments for consideration. The Examiner further requested that Applicants consider the proposed claims in view of U.S. Patent No. 6,567,850 (hereinafter “Freishtat”). No agreement on the allowability of Claim 1 was reached,

however Examiner seemed to be of the opinion that at least Claim 96 was patentable over the cited references.

II. ADDED CLAIMS

As described during the Interview, Claim 1 recites a method that, among other purposes, facilitates content-based billing based on one of: 1) a message intercepted in transit **from a requestor to a provider**; or 2) a message intercepted in transit **from the provider to the requestor**. As further discussed in the Interview, Claim 96 addresses the latter scenario exclusively. The Examiner acknowledged that *Kawecki* did not appear to suggest content-based billing based on a message intercepted in transit **from the provider to the requestor**, within the meaning recited in Claim 96. The Examiner further stated that the method would have advantages such as ensuring that entities are not billed for content that is requested but not delivered (for example, in the event of requests sent during and/or as part of a denial-of-service attack).

To simplify prosecution with respect to the subject matter discussed during the interview, Applicants presently amend the claims to include an independent claim 116 that is directed exclusively to the second of the two scenarios described above—in other words, content-based billing based on a message intercepted in transit from the provider to the requestor. Applicants note that while, in some respects, Claim 116 is broader in scope than Claim 96, Claim 116 still features at least the same patentable feature of Claim 96 as was discussed in the interview. Applicants further submit that the added claims do not add any new matter to this application and are supported by the Specification as originally filed.

III. AMENDED / CANCELED CLAIMS

The amendments to the claims do not add any new matter to this application and are supported by the Specification as originally filed. For example, support for the

amendments to the claims may be found in, among other passages, page 6–8. Applicants further submit that support for the amendments is found in the understanding one skilled in the art would have had, at the time the instant application was filed, of HTTP proxies and similar devices, as discussed in the Specification, as well as the nature of the messages (e.g. IP packets) they are designed to relay. The amendments to the claims, which may broaden certain aspects of the amended claims, were made to improve the readability and clarity of the claims.

Canceled claims 102–111, which had been formerly withdrawn, were canceled solely in the interest of expediting prosecution as to the pending claims, and not for any reason related to the patentability of the subject matter described in canceled claims 102–111.

IV. CLAIM REJECTIONS BASED ON 35 U.S.C. § 112

A. *First Paragraph*

Claims 1 and 38 and their dependents (claims 1-4, 6-9, 11, 12, 15, 16, 18, 25, 29-33, 36-39, 41-44, 46, 47, 50, 51, 53, 60, 64-68, 71-77, 84-89 and 96-101) stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The rejection was based on, specifically, allegations that the original disclosure did not describe “one or more computers programmed to be special purpose machines” and “service identifying information in the message including data other than the provider identifier information.” Applicants disagree with the allegations. Nonetheless, Claim 1 presently does not recite either of the above features. Therefore, the rejection is moot. Removal of the rejection is respectfully requested.

B. Second Paragraph

Claims 1-4, 6-9, 11, 12, 15, 16, 18, 25, 29-33, 36-39, 41-44, 46, 47, 50, 51, 53, 60, 64-68, 71-77, 84-89 and 96-101 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The rejection was based on, specifically, allegations that the bounds of “data other than the provider identifier information” are not clear. Applicants disagree. Nonetheless, Claim 1 presently does not recite the phrase “data other than the provider identifier information.” Therefore, the rejection is moot. Removal of the rejection is respectfully requested.

V. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

A. Kaweck and Hosea.

Claims 1-4, 12, 15, 16, 18, 36, 38, 39, 47, 50, 51, 53, 71, 73-75, 77, 78-82, 84-86, 88, 89 and 91-94 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,963,625 (hereinafter *Kaweck*) in view of U.S. Patent Application No. 2002/0138331 (hereinafter *Hosea*). This rejection is respectfully traversed.

CLAIM 1

Claim 1 presently recites, among other elements:

intercepting a message that has been sent from a first
participant to a second participant prior to said
message arriving at said second participant;

...

wherein said first participant is one of a requestor and a
provider and the second participant is the other of
the requestor and the provider;

wherein **the message is addressed to or addressed from a particular address**, the particular address being a unique Internet Protocol address;

wherein the particular address is associated with the provider;

wherein the provider provides a plurality of different types of content in response to requests addressed to the particular address;

...

based on the intercepted message, software managed by the third party performing the steps of:

based on **information in the message other than the particular address, determining what content, of a plurality of different types of content provided by the provider at the particular address, is being provided by or requested** from the provider in the message;

...

if said content has billing implications, sending billing data to a billing service, the billing data being based on the determined content;

For example, the method of Claim 1 may be implemented by a traffic server through which TCP/IP traffic between the requestor and provider must be routed. The provider may run a web server at the particular IP address. The provider may provide a plurality of different types of content from this web server. Rather than bill the provider or requestor a flat rate for all traffic between the requestor and the web server at the indicated IP address, the traffic server determines what content of the plurality of different types of content is being requested or provided in a particular message (e.g. a particular IP packet). Since the IP address will be the same no matter which content is requested, the determination must be made based at least on information in the message other than the IP address. For example, if the message is an IP packet, the information consulted may be a request or response in the "payload" field of the IP packet that indicates the path portion of the URL accessed by the requestor.

The cited references fail to teach or suggest such a method. While *Kawecki* teaches that a toll switch intercepting telephone connection requests from a caller may

provide billing services to the dialed 1-900 provider, *Kawecki* is inapplicable to the context of Claim 1. At best, *Kawecki*'s telephone numbers are analogous to IP addresses, in that the connection requests are addressed to or addressed from a particular address.

Whereas the method of Claim 1 involves differentiating between many different types of content that can be requested from a particular IP address, *Kawecki*'s toll switch would be oblivious to and therefore incapable of differentiating between many different types of content requested from a 1-900 number. Thus, *Kawecki* cannot teach or suggest “determining what content, of a plurality of different types of content provided by the provider at the particular address,” as recited in Claim 1.

The Office Action alleges that the features of Claim 1, as formerly recited, could be met by taking into account the use of extensions, or by partitioning a telephone number into an area code and an exchange. With regards to extensions, a toll switch would be entirely unaware of what extension a user had dialed. *Kawecki*'s toll switch is simply responsible for connecting a requestor to a provider. *Kawecki*'s toll switch does not then listen in on the telephone call to determine what extension the user dials.

With regards to partitioning the telephone number, Claim 1's address, as presently recited, is the entire IP address to which the message is addressed. An IP address is associated with a specific system responsible for responding to or originating the message. To interpret Claim 1's IP address as being analogous to anything other than an entire phone number—i.e. the number of the specific telephone system responsible for responding to the message—would be unreasonable.

The Office Action also alleges that *Hosea*'s disclosure of a URL having service identifying information therein teaches or suggests various aspects of Claim 1, as formerly recited. Applicants willingly admit that the use of URLs to identify both a domain name and a specific service is well known. However, the combination of *Hosea* and *Kawecki* still does not teach one to **bill participants based on a determination of “what content, of a plurality of different types of content provided by the provider at the particular address.”**

For at least the foregoing reasons, the combination of *Kawecki* and *Hosea* fails to provide the complete subject matter recited in independent Claim 1. Therefore, the combination of *Kawecki* and *Hosea* would not have rendered Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

BROADEST REASONABLE INTERPRETATION OF “MESSAGE”

On a side note, the Office Action alleges that the broadest reasonable interpretation of the words “message” in Claim 1 is “information sent or conveyed.” While this allegation does not appear to have any relevance to the claims as presently amended, it may nonetheless be useful for Applicants to clarify that this interpretation, while broad, is unreasonable in view of the features recited in Claim 1.

The message of Claim 1 must meet a number of recited criteria, including:

- a. The message must include an IP address, identifier information, and information other than the IP address that indicates what content is requested or provided
- b. The message must be something that is sent from one party to another
- c. The message must be something that can be intercepted at one device prior to being received by a recipient

In view of these criteria, it would be unreasonable to interpret the word “message” as used in Claim 1 to be, simply, “information sent or conveyed.” Certainly, one could not interpret the entire contents of a two-way telephone call as a single message.

INDEPENDENT CLAIM 38

Independent Claim 38 also recites features argued above with relation to Claim 1, although Claim 38 is expressed in another format. Because Claim 38 has at least one of the features described above for Claim 2, Claim 38 is therefore allowable over the combination of *Kawecki* and *Hosea* for at least one of the same reasons as given above for Claim 2. Reconsideration is respectfully requested.

CLAIMS 77-82 AND 93-94

The Office Action continues to reject Claims 77-82 and 93-94, even though each of Claims 77-82 is either withdrawn or canceled. Based on the current status of Claims 77-82 and 93-94, as well as the Office Action's non-responsiveness to Applicant's previous arguments concerning those Claims, Applicants believe the inclusion of the rejections in the Office Action was in error. Nonetheless, Applicants submit that these claims are patentable over the cited references for at least the same reasons as set forth in the previous response.

CLAIMS 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 AND 91-92

Each of Claims 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 and 91-92 depends from Claims 1 or 38 and includes the above-quoted features of its parent claim by dependency. Thus, the combination of *Kawecki* and *Hosea* also fails to teach or suggest at least one feature found in Claims 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 and 91-92. Therefore, the combination of *Kawecki* and *Hosea* does not render obvious Claims 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 and 91-92. Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 and 91-92 recites at least one feature that independently renders it patentable. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2-4, 12, 15, 16, 18, 36, 39, 47, 50, 51, 53, 71, 73-75, 84-86, 88, 89 and 91-92 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

B. *Kawecki, Hosea and Oliver.*

Claims 11, 20, 31-33, 37, 46, 55, 66-68, and 72 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki, Hosea and Oliver* in view of U.S.

Patent Application No. 2002/0133412 (hereinafter *Oliver*). The rejection is respectfully traversed.

Each of Claims 11, 20, 31-33, 37, 46, 55, 66-68, and 72 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Oliver*. In fact, the Office Action did not rely upon *Oliver* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Oliver* fails to teach or suggest one or more features of Claims 11, 20, 31-33, 37, 46, 55, 66-68, and 72. Thus, Claims 11, 20, 31-33, 37, 46, 55, 66-68, and 72 are patentable over the combination of *Kawecki*, *Hosea*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and *Oliver*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 11, 20, 31-33, 37, 46, 55, 66-68, and 72 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

C. *Kawecki, Hosea and Malik.*

Claims 6, 7, 26, 41, 42, 61, 76 and 87 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki* in view of *Hosea* and further in view of U.S. Patent No. 6,873,691 (hereinafter *Malik*). The rejection is respectfully traversed.

Each of Claims 6, 7, 41, 42, 76 and 87 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Malik*. In fact, the Office Action did not rely upon *Malik* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Malik* fails

to teach or suggest one or more features of Claims 6, 7, 41, 42, 76 and 87. Thus, Claims 6, 7, 41, 42, 76 and 87 are patentable over the combination of *Kawecki*, *Hosea*, and *Malik*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and *Malik*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 6, 7, 41, 42, 76 and 87 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D. Kawecki, Hosea, Oliver and Manabe.

Claims 8 and 43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Oliver* and in further view of U.S. Patent No. 5,339,239 (hereinafter *Manabe*). The rejection is respectfully traversed.

Each of Claims 8 and 43 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Oliver* and *Manabe*. In fact, the Office Action did not rely upon *Oliver* or *Manabe* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, *Manabe*, and *Oliver* fails to teach or suggest one or more features of Claims 8 and 43. Thus, Claims 8 and 43 are patentable over the combination of *Kawecki*, *Hosea*, *Manabe*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, *Manabe*, and *Oliver*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 8 and 43 are not provided at this time. Applicants reserve the right to further

point out the differences between the cited art and the novel features recited in the dependent claims.

E. Kaweck, Hosea, Oliver, Manabe and Hartley-Urquhart.

Claims 9 and 44 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kaweck, Hosea, Oliver, and Manabe* and in further view of U.S. Patent No. 6,167,385 (*Hartley-Urquhart*). The rejection is respectfully traversed.

Each of Claims 9 and 44 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kaweck* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kaweck* and *Hosea*, are also missing from *Oliver, Hartley-Urquhart, and Manabe*. In fact, the Office Action did not rely upon *Oliver, Hartley-Urquhart, or Manabe* for teaching the one or more features. Consequently, the combination of *Kaweck, Hosea, Manabe, Hartley-Urquhart, and Oliver* fails to teach or suggest one or more features of Claims 9 and 44. Thus, Claims 9 and 44 are patentable over the combination of *Kaweck, Hosea, Manabe, Hartley-Urquhart, and Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kaweck, Hosea, Manabe, Hartley-Urquhart, and Oliver*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 9 and 44 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

F. Kaweck, Hosea, and Clarke.

Claims 25 and 60 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kaweck* in view of *Hosea* and U.S. Patent No. 5,502,636 (hereinafter *Clarke*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 25 and 60 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kaweck* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kaweck* and *Hosea*, are also missing from *Clarke*. In fact, the Office Action did not rely upon *Clarke* for teaching the one or more features. Consequently, the combination of *Kaweck*, *Hosea*, and *Clarke* fails to teach or suggest one or more features of Claims 25 and 60. Thus, Claims 25 and 60 are patentable over the combination of *Kaweck*, *Hosea*, and *Clarke*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kaweck*, *Hosea*, and *Clarke*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 25 and 60 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

G. Kaweck, Hosea and Hahn-Carlson.

Claims 29, 30, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kaweck* in view of *Hosea* and further in view of U.S. Patent No. 6,704,612 (hereinafter *Hahn*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 29, 30, 64 and 65 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kaweck* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kaweck* and *Hosea*, are also missing

from *Hahn*. In fact, the Office Action did not rely upon *Hahn* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Hahn* fails to teach or suggest one or more features of Claims 29, 30, 64 and 65. Thus, Claims 29, 30, 64 and 65 are patentable over the combination of *Kawecki*, *Hosea*, and *Hahn*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and *Hahn*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 29, 30, 64 and 65 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

H. The Remaining Claims

The Office Action does not expressly describe the bases of rejection for a number of claims, including Claims 96–101. Applicants submit that these claims are patentable over the cited references for at least the reasons discussed above. Additionally, each of these claims recites at least one additional feature that independently renders it patentable over the references cited above.

CLAIM 96

Although the Office Action does not expressly describe a basis of rejection for Claim 96, the Office Action nonetheless alleges that the cited references teach or suggest Claim 96 because *Kawecki* describes the timing of telephone calls. The Office Action is in error. Claim 96 recites, generally speaking, determining the content of messages intercepted in transit from a provider to a requestor. While *Kawecki* does monitor the length of a telephone call, this telephone call is not a message within the meaning of Claim 96, *see arguments with respect to Claim 1*, nor is *Kawecki*'s toll switch capable of determining what content is in the telephone call. The length of a telephone call does not

reveal the contents therein. For at least these reasons, Claim 96 is patentable over the cited references.

CLAIMS 97–101

To expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 96–101 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

VI. FREISHTAT

During the Interview, the Examiner requested that Applicants consider the proposed claims in view of U.S. Patent No. 6,567,850 (hereinafter “*Freishtat*”). Applicants have read over what appear to be the most relevant passages of *Freishtat*, and it appears that *Frieshtat* describes nothing more than an intermediary that aggregates Personal Information (“PI”), such as passwords and credit card numbers, on behalf of users. While certain techniques are described as being performed at an intermediary, it appears that users address their communications directly to the intermediary, as opposed to any sort of provider. In other words, *Freishtat* does not intercept messages as recited in the claims. Moreover, *Frieshtat*’s techniques do not involve billing participants based on messages—at best, *Freishtat* states that an intermediary may be charged, or that information about bills may be part of the aggregated “PI.” For at least these reasons, Applicants submit that *Freishtat* is no more relevant to the present claims than the currently cited references.

VII. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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